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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,453	11/01/2001	Steven O. Markel	INTE.18USU1 (ITC16)	4290

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EXAMINER	
POLTORAK, PIOTR	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/045,453	MARKEL, STEVEN O.	
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-17* is/are pending in the application.

4a) Of the above claim(s) *12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-11 and 13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment, and remarks therein, received on 2/06/06 have been entered and carefully considered.

Response to Amendment

2. Applicant's arguments have been carefully considered but they were not found persuasive.
3. Addressing the previous Office Action 35 USC § 112 rejection applicant addresses terminology that was indicated as not understood.
4. As per claims 1 applicant defines the term "constraint". Applicant points to pg. 2 lines 4-6 of the specification that addresses possible interpretation of a platform or a target platform and applicant explains that "the specification discloses numerous difference between platforms, and lists some of those differences and describes them as "constraints" that differ between platform" (remarks pg. 5).
5. The examiner points out that the specification merely provides some examples but does not clearly define the term. However, given the fact that applicant did not challenge the examiner's interpretation, the examiner continues to treat the term in the broadest reasonable interpretation. Similarly, the 35 USC § 112 rejection regarding other not clearly defined terms (e.g. "authoring options", "platform rules" etc.) is withdrawn and the broadest reasonable interpretation extended by applicant's allowed interpretation of the specification regarding the cited terms is applied. (For example, one of ordinary skill in the art would not necessarily treat "authoring program" or "authoring options" as recited in the claim language as an

equivalent to "program which authors" or "options that author" as implies applicant's interpretation of the specification.)

6. As per claim 1-2, 7-8 and 13-17 applicant argues that the art of record alone or with motivation teach different constraint for different display platform. Applicant states that "different constraint for different display platform" is the heart of the invention and as a result the examiner's obviousness statement without the support of additional art is impermissible hindsight (remarks, pg. 9).
7. Applicant's arguments have been carefully considered but they were not found persuasive. Convington explicitly discloses that rules are implemented on a particular platform (an IBM PS2 personal computer with a 25 Mhz Intel 80386 microprocessor and 8 magabytes of RAM, col. 4 lines 11-15) and clearly states that the present invention is for a plurality of platforms and even a plurality of types of platforms (col. 4 lines 8-10). As a result it is clear that the rules disclosed by Convington describe constraint for more than one display platforms.
8. Applicant's arguments towards claims 5-6 addressing the order of the steps are persuasive and amendment to claims 9-11and 15-17 address the deficiencies addressed in the previous Office Action. As a result the rejection towards claims 5-6, 9-11and 15-17 are withdrawn.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7-8 and 13-17 remains rejected under 35 U.S.C. 102 (b) as being anticipated by Convington (U.S. Patent No. 5524193).

Convington teaches a multimedia program implemented on a plurality of platforms (Abstract and col. 4 lines 1-40).

10. As per claim 1, 7-8 and 13-17 Convington teaches establishing a set of rules describing at least one constraint for at least two display platforms (col. 13 lines 37-43), employing the set of rules to define options in an authoring program (col. 13 lines 37-43), employing the authoring program to perform an authoring action (col. 13 lines 54-60), saving a media enhancement file (col. 4 lines 18-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 5-6 and 9-11 remain rejected under 35 U.S.C. 103(a) as being anticipated over Convington (U.S. Patent No. 5524193) in view of Official Notice.

As per claims 5-6 Convington teaches rules as discussed above.

Convington does not explicitly teach that the created rules are downloaded to a display platform.

Official Notice is taken that it is old and well-known practice to download rules. One of ordinary skill in the art at the time of applicant's invention would have been

motivated to allow downloading in order to allow additional ways to access/receive/updates rules.

12. As per claims 9-11 Convington teaches graphic elements (e.g. Abstract and Fig. 1) but does not explicitly teach different formats and colors available for the element selection.

Official Notice is taken that it is old and well-known practice to provide different sizes, colors and/or formats for graphic element selection (e.g. Microsoft Word). One of ordinary skill in the art at the time of applicant's invention would have been motivated to provide a different colors for sizes, colors and/or formats for graphic element selection in order to articulate and make more interesting the multimedia material. Providing multiple varieties of sizes, colors and/or formats results in checking users' selection.

13. Claims 3-4 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Convington (U.S. Patent No. 5524193) in view of MacPhail (U.S. Patent No. 6593943).

Convington teaches set of rules as discussed above.

Convington et al. do not teach that the set of rules comprising an XML compliant file.

MacPhail teaches a set of rules comprising an XML compliant file (col. 8 lines 43-49 and col. 6 line 58-col. 7 line 9).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a set of rules comprising an XML compliant file as taught by

MacPhail. One of ordinary skill in the art would have been motivated to perform such a modification in order to have a set of rule suitable for data transmission.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached on (571) 272-6962. The fax phone

number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/13/06

JOSEPH H. LOUIS JR.
PRIMARY EXAMINER